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KD

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/145,987	09/03/98	NAKANISHI	2224-0142P

HM12/1026
BIRCH STEWART KOLASCH & BIRCH
P O BOX 747
FALLS CHURCH VA 22040-0747

EXAMINER

WHITE, E

ART UNIT PAPER NUMBER

1623

DATE MAILED: 10/26/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/145,987

Applicant(s)
NAKANISHI et al.

Examiner
WHITE

Group Art Unit
1623



☒ Responsive to communication(s) filed on June 24, 1999 and August 12, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-13 and 15-22 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-13 and 15-22 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. Amendment A filed June 24, 1999 and Amendment B filed August 12, 1999 has been received and entered into the record.
2. Claims 1-13 and 15-22 are pending in the case.
3. All 35 U.S.C. statutes not cited in this Office action can be found cited in full in a previous Office action.

35 U.S.C. 103 Rejection

4. Claims 1-13 and 15-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii et al (US Patent No. 3,816,150) for the reasons already of record on pages 4 and 5 of the Office action mailed February 25, 1999.
5. Applicant's arguments filed June 24, 1999 have been fully considered but they are not persuasive. Applicants arguments on pages 11-16 of their response filed June 24, 1999 with regard to the instant claimed cellulose acetate exhibiting improved properties base on heat resistance, releasability, transparency and spinnability properties have been carefully considered. However, the arguments are not persuasive because when the claimed and prior art compounds possess a close structural relationship and a specific significant property in common which renders the claimed compounds obvious to one skilled in the art, they are effectively placed in the public domain and unpatentable per se, even though the applicant has discovered that they possess an additional activity. It appears that applicants have made modifications in the process for preparing cellulose acetate which only increase the effectiveness of properties of cellulose acetate that are already well known to the skill artist. The fact that a claimed composition is more effective than anticipated is not persuasive of unobviousness where what is claimed would flow naturally from the teachings of the prior art. No unexpected results has been disclosed in the instant application. Accordingly, the rejection of claims 1-13 and 15-22 under 35 U.S.C. 103(a) as being unpatentable over the Ishii et al patent is maintained.

6. Claims 18-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Seo et al (US Patent No. 5,240,665) in view of Ishii et al (US Patent No. 3,816,150) for the reasons already of record on page 5 of the Office action mailed February 25, 1999.

7. Applicant's arguments filed June 24, 1999 have been fully considered but they are not persuasive. The patentability of instant claims 18-21 are dependent upon the patentability of the instant claimed cellulose acetate as set forth in instant claims 1-13 and 15-17. However, as discussed in the above rejection, the cellulose acetate do not appear to be patentable over the Ishii et al patent. Therefore, the rejection of claims 18-21 under 35 U.S.C. 103(a) as being unpatentable over the Seo et al and Ishii et al patent is also maintained for the reasons disclosed in the above art rejection over the Ishii et al patent alone.

8. All the claims are rejected.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. White whose telephone number is (703) 308-4621. The examiner can normally be reached on Monday-Friday from 8:30 AM to 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

E. White

White
October 14, 1999

Gary L. Kunz
GARY L. KUNZ
PRIMARY EXAMINER
GROUP 1200